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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/994,701

11/06/2001

Richard C. Willson

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26830 7590 04/07/2009
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EXAMINER

BURKHART, MICHAEL D

ART UNIT

PAPER NUMBER

1633

MAIL DATE

DELIVERY MODE

04/07/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/994,701

Applicant(s)

WILLSON ET AL.

Examiner

MICHAEL BURKHART

Art Unit

1633

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 March 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 10-13, 16, 22-25, 29, 30, 32 and 34-44.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Michael Burkhardt/
Primary Examiner, Art Unit 1633

Continuation of 3. NOTE: Claim 10 has been amended to recite a step of "exposing the solid composition to an eluant which selectively elutes the polynucleotide target compound", a limitation not previously recited in the claims. Claim 12 has been amended to include a step of "eluting" and collecting purified samples of a target compound, wherein the claim previously recited only collecting the compound. Finally, new claims 44-49 have been added, and are by definition unexamined. Thus, a new search would have to be performed, and the prior art and specification considered for support of the new limitations.

Continuation of 11. does NOT place the application in condition for allowance because: Claims 22-25, 29, 30, 32, 35, 36, 41 and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Petty (Curr. Protocols Mol. Biol., 1996, of record). This rejection is maintained for reasons made of record in the Office Action dated 2/8/2005, 6/27/2006, 1/22/2009, and for reasons set forth below.

Response to Arguments

Applicant's arguments filed 3/23/2009 have been fully considered but they are not persuasive. Applicants arguments directed to amended claims (i.e. those that recite collecting a target compound substantially free of protein) are moot if reliant upon entry of the amendment because the amendment has not been entered. Furthermore, various claims asserted by applicants to be rejected by Petty (10, 44, etc) are not so rejected. See the above rejection and that from the final Office Action dated 1/22/2009. Arguments directed to claims not found in this rejection are moot.

Claims 10-13, 16, 32, 34, 36-40 and 42-44 are rejected under 35 U.S.C. 102(b) as anticipated by Verdine et al (WO 98/00435, of record) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Verdine et al as evidenced by Min et al (Nuc. Acids Res., 1996, pages 3806-3810).

Response to Arguments

Applicant's arguments filed 3/23/2009 have been fully considered but they are not persuasive. Applicants arguments directed to amended claims are moot for the reason set forth above. Applicants assert that Verdine shows the invention is not obvious because Verdine had to use histidine tags. This is not persuasive because this is not a purely obviousness rejection: it is a 102 rejection, with use of another citation to render a limitation inherent (i.e. Min et al). Applicants assert that Petty only teaches his-tagged proteins, does not achieve elution or collection of Applicants product, and that Petty's product is protein. This is not persuasive because Petty is not part of this rejection. Applicants assert that Verdine does not collect purified DNA as recited in claim 32. This is false in light of the teachings of Verdine et al, and as outlined in the previous Office Action on page 7 (emphasis added):

"Supernatant containing contaminants such as the DNA polymerase was removed and purified DNA bound to the IMAC column was eluted with imidazole (Example 3, page 11)."